



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Alexander WONG

Group Art Unit No.: 2151

Examiner: Khanh Dinh

Serial No.: 09/870,059

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For: METHOD AND APPARATUS FOR
NETWORK CONTENT DISTRIBUTION
USING A PERSONAL SERVER APPROACH

Mail Stop AF
Commissioner of Patents
P. O. Box 1450
Alexandria, Virginia 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

Applicant requests review of the last rejection of claims in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated on the attached sheets. The undersigned is an attorney of record.

Respectfully submitted,

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Dated: December 20, 2006

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CERTIFICATE OF MAILING

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on December 20, 2006

By


Teresa Austin

REASONS FOR REQUEST

I. The Examiner's Reading of Gupta is Clearly Erroneous Because It Is Not Applied to the Actual Claim Language

All independent claims are rejected over Reisman, Bergman and Gupta. Gupta is newly cited. The Office Action contends that Gupta's Abstract, FIG. 2, 4:37 to 5:57, and 6:17-48 show the claim features of "initiating execution, in a client computer that is coupled over a public network to one or more content servers, of a personal of a personal [server]¹ that is hosted within the client; ... wherein the receiving, storing, selecting, retrieving and synthesizing are carried out by a the personal server that executes at the client." In a telephone interview held December 19, 2006, the Examiner stated that he reads Gupta FIG. 2 and col. 4-6 to describe a computer that can act as both client and server.

However, claim 1 does not recite a computer that can act as both client and server. Instead, claim 1 and all other independent claims recites a personal server that is **hosted within a client computer** that is connected over a network to **other servers**. The personal server has specific functions that are not found in any reference—such as **synthesizing electronic documents** based on incoming content channels.

Thus, the Examiner is not applying Gupta to the claims properly. The Examiner is basing a rejection on a description in Gupta of something other than what is claimed. It is clear error to apply a reference to something other than what is actually claimed because the statute authorized rejection only of "the subject matter sought to be patented," 35 U.S.C. 103(a), and "the claims must be considered in their entirety," as stated in *Rockwell Int'l Corp. v. United States*, 147 F.3d 1358, 1364 (Fed. Cir. 1998). Further, the courts require interpreting the claims in light of the specification, *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)—indeed, *Phillips* "stressed the dominance of the specification" in claim interpretation, *On Demand Machine Corp. v. Ingram Industries, Inc.*, No. 05-1074, slip op. at 8 (Fed. Cir. March 31, 2006)—and any reading of the present claims in light of Applicant's specification compels the conclusion that the Examiner is misapplying Gupta.

No reasonable reading of Gupta can correlate the parts of Gupta relied upon by the Examiner to the claims. Gupta relates to displaying streaming media content using Windows Media Player and has no real relevance to Applicant's claims. The Abstract of Gupta only describes a conventional client and does not describe a personal server as claimed. FIG. 2

¹ The Office Action states "personal computer," which is not the correct claim term.

describes a generic networked personal computer, but the computer does not include a personal server hosted within the computer. 4:37 to 5:57 merely describes FIG. 2. 6:17-48 states that a network client can “select or request identified composite media streams” from the server (6:22-25). Thus, complete composite media streams **already exist at the server** and are merely requested and displayed in streaming mode at the network client—the network client has no role in **creating** the streams. In contrast, the claimed personal server **synthesizes personalized electronic documents within the client**; unlike Gupta, in the claimed approach composite content is created within the client.

The diagrams and text of Gupta uniformly presume the client to be separated from the server by a network. There is no description or suggestion of a personal server hosted within or located at the client as claimed—indeed, the claimed approach of having a personal server within the client is so non-conventional and counter-intuitive that it is perhaps beyond the Examiner’s frame of reference. Gupta Fig. 1 shows client and server separated by network; Col 1, line 33 states that “The term ‘streaming’ is used to indicate that the data representing the various media types is provided over a network to a client computer”; Col 3, line 6 states that “...the computers communicate with each other over a data communications network”; Col 7, line 38 states that a “...single server sends composite media stream to client, which demultiplexes it” (See also Figs. 3 and 4).

In contrast, in one embodiment of the present claims, the personal server at the client receives data from multiple remote servers and combines (or multiplexes, in the same parlance) it into a single document, which is the exact opposite of what Gupta teaches. Because the Examiner has clearly erred by applying Gupta to something other than what is claimed, based on an unreasonable reading of Gupta, the present request should be granted.

The rationale of the Office Action for combining Gupta with Reisman—that “it would have established a communications link between computers in a communication network”—is irrelevant with respect to the claims. Gupta has no suggestion to somehow transform the network client of Gupta into a personal server with all the claimed features.

II. The Office Action’s Reliance On *Reisman* is Clearly Erroneous Because *Reisman* Does Not Provide a Server Within a Client

Claim 1 and each of the other independent claims recites a method whose steps are carried out by a personal server that executes at the client. Reisman FIG. 12 shows all servers (136, 132) separated from the client (local station 122) by the telephone network, ISP, and

Internet. Reisman FIG. 6 shows the server separated from the client by component 14. The Reisman server must use a connection protocol to contact the user—clearly indicating separation. Col. 16 of Reisman describes FIG. 6, stating that the user contacts component 14 through a “call connection,” which must occur through a network such as the PSTN. The examples (col. 17, 18) all involve communication through a network to the server. No reasonable interpretation can find that the Reisman server is “at” the client.

Claim 1 recites a method that retrieves updated channel content without communicating the channel selection information across the network. Reisman, however, communicates all selection information across the network (col. 15 line 22).

III. The Office Action’s Reliance On *Bergman* is Clearly Erroneous Because *Bergman* Does Not Provide “Synthesis” As Claimed

Claim 1 recites a method that synthesizes original, personalized electronic documents from updated channel content from various sources. The Office Action contends that Bergman discloses the claimed synthesis step. While both Applicant’s claims and Bergman use the term “synthesis,” Applicant’s usage refers to a process and method that is distinct from and unrelated to Bergman. In Applicant’s claims, “synthesizing” may refer to combining different channel content from various sources into one or more different electronic documents. In Bergman, however, “synthesis” refers to transformation of formats or “modalities” of a single multimedia content unit into a format suitable for consumption based on the characteristics of the delivery platform and medium (col. 6, lines 15-38 and col. 7 lines 1-25). Bergman does not disclose a method wherein a user may select content from various sources (multiple terminal objects) and have them synthesized together into a single electronic document based on the user’s specification.

Bergman describes a Multimedia Content Description Framework (MCDF), which provides for an InterObject Description Scheme (IODS) that can describe relationships between multiple terminal objects (col. 15 line 5 to col. 20 line 54). However, the MCDF IODS is a *descriptive framework* for describing fixed, pre-existing relationships between terminal objects stored at remote server archives. MCDF does not provide a *constructive method* for an end-user at the client to specify novel, arbitrary, and personalized relationships between terminal objects, as reflected in Applicant’s claims.

In Bergman, the synthesis process occurs at remote archive, proxy content, and adaptation filter servers (FIG. 1, 2). In Applicant’s claims, the synthesis occurs at a personal

server that executes at the client. Furthermore, the claimed method performs updates and synthesis without communicating channel selection information across the network, thereby keeping the channel selection information private. In contrast, Bergman explicitly communicates all synthesis information across the network, thereby making the synthesis information public (col. 5 lines 15-65).

For at least the foregoing reasons, neither Reisman nor Bergman teaches or suggests the independent claims, whether the references are taken alone or in combination. Because of the differences between the independent claims and the base reference, no combination of Reisman and Bergman can provide the complete claimed subject matter. Therefore, a *prima facie* case of obviousness is not established, and the present request should be granted.

IV. The Office Action's Reliance On Linden is Clearly Erroneous Because Linden's Tokens Are Not What is Claimed

Claims 12, 13, 33, and 38 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Reisman, Bergman, Gupta and Linden. Linden shows a system where URL links are encoded with an authentication token at a remote server, and are then sent to users via e-mail. When users activate those URL links, they are returned to the remote server where the encoded authentication token in the URL is validated to allow access to a private resource.

Claim 12 recites a method where a content server embeds multiple content tokens (not authentication tokens) into channel content (not URL links). Channel content is received by the client (not via e-mail), and the tokens are replaced by other channel or personal content at the client. The client does not use these tokens to return to the remote server as in Linden.

Neither Linden nor Reisman show a personal server executing at the client. Neither Linden nor Reisman show an iteration of a replacement step over channel content by a personal server executing at the client. Reisman teaches away from a combination with Linden. Reisman describes a "transporter [which] automatically effects communication sessions" (Abstract) whereas in Linden, the user must manually access and activate private URLs sent through e-mail. Linden's manual user interaction is precisely what Reisman's invention intends to reduce or eliminate.

The Office Action also relies on Linden FIG. 1, and col. 3, line 31 to col. 4, line 56. Linden's tokens are distinct in function and purpose from the tokens referred to in Claim 12. In Linden, tokens are generated at the server, sent to users via e-mail, and then returned to the server again via a URL. In Claim 12, the tokens are embedded in updated channel content,

which are retrieved by the user, and are never returned to the server. The mere presence of a keyword in a reference does not mean that the reference teaches or suggests the invention.

In Linden, the user does not replace the token. In fact, for Linden's scheme to work, the token must not be replaced, otherwise the validation step will fail. In Claim 12, the tokens embedded in the updated channel content are replaced at the user station with other updated channel content or personal content information located at the client.

In Linden, the token acts a unique identifier. In Claim 12, the token is not unique, but rather is a placeholder to be replaced by updated channel content or personal content information located at the client. A token may be embedded multiple times in the updated channel content, and therefore the tokens are not necessarily unique, as they must be in Linden. In Linden, the token is associated with a user record stored in a database on the server. In Claim 12, the tokens are not associated with any information stored on the server. To the contrary, the tokens in Claim 12 are associated with and refer to updated channel content or personal content information located at the client.

For at least the foregoing reasons, the present request should be granted.

V. Further Action Based on *Parry* Is Impermissible and Prejudicial

Less than 24 hours before the telephone interview of December 19, 2006, the Examiner called Applicant's representative and stated that the Parry reference (identified in an IDS filed concurrently herewith) would be used in another Office Action if Applicant replied to the current Office Action. If the present request is granted, further rejection based on Parry or any other equally irrelevant reference is impermissible. In rejecting claims, "the examiner must cite the best references at his or her command." 37 C.F.R. 1.104(c)(2). The present Office Action is the fourth action in the case. The Office has had three opportunities to search and present art, all of which Applicant has overcome. Parry and Gupta do not reasonably relate to the claimed approach. The continued citation of new references, each less relevant than the last, violates Office rules and policy against piecemeal prosecution, needlessly compounds costs, and may rob the Applicant of patent term.